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ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	PERKINS COIE LLP		
Signature			
Printed name	Stephen E. Arnett		
Date	January 27, 2005	Reg. No.	47,392



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: KURT CLEMENT
APPLICATION NO.: 09/518,787
FILED: MARCH 3, 2000
FOR: **SOFTWARE DISTRIBUTION METHOD
AND APPARATUS**

EXAMINER: JAMES A. REAGAN
ART UNIT: 3621
CONF. NO: 7353

Reply Brief Under 37 C.F.R. §41.41

MS Reply Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief responds to the Examiner's Answer dated December 2, 2004 in the above-identified application.

Under 37 C.F.R. §41.39(b), if the Examiner's Answer contains a rejection *designated* as a new ground of rejection, the Appellant can maintain the Appeal by filing a Reply Brief as set forth in 37 C.F.R. §41.41. In the Examiner's Answer of December 2, 2004, the Examiner indicated he was issuing new grounds of rejection, but the Examiner failed to *designate* which grounds of rejection he understood to be the new grounds. The Appellant maintains that the Examiner's Answer does not contain new grounds of rejection per se. Rather, the Examiner's Answer simply repeats the rejections raised in the Final Office Action, and cites some new text from the Wyman reference in an attempt to fill the gaps in the claim rejections identified by the Appellant in his Appeal Brief. Nevertheless, the Appellant has elected to file the present Reply Brief in an effort to comply with 37 C.F.R. §41.39 and maintain the Appeal. Because the grounds of rejection remain largely unchanged, this Reply Brief includes much of the substance from the prior Appeal Brief and addresses the additional text from the Wyman reference discussed in the Examiner's Answer.

This Reply Brief is transmitted in triplicate.

This Reply Brief contains items under the following headings, as required by 37 C.F.R. § 41.37:

- I. Real Party In Interest
- II Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Invention
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument
- VIII. Appendix: Claims Involved in the Appeal

REAL PARTY IN INTEREST

The real party in interest for this appeal is Micron Technology, Inc., the owner of the present application.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences that will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

STATUS OF CLAIMS

There are 29 claims pending in the application. No claims were cancelled or withdrawn during prosecution. Claims 1-29 stand rejected and are the subject of this appeal.

STATUS OF AMENDMENTS

The claims have not been amended subsequent to the final rejection in the Final Office Action dated February 10, 2004.

SUMMARY OF INVENTION

Digital data products include computer software applications, data files, artistic and informational recordings, and the like. Such products are typically distributed to end users in one of two ways. The first way involves storing the digital data on a recording media and distributing the media to end users through conventional retail channels. This approach has the downside of requiring suppliers and retailers to bear the cost of the time value of money while inventory sits on their shelves. Another method for distributing these products is to enable users to download electronic copies of the information over a network, such as a local or wide area network, or the Internet. Distribution by downloading, however, can be relatively time-consuming and inconvenient because of the relatively low bandwidth of the network. The inconvenience of downloading can discourage some users from purchasing the related product. (P. 2, ll. 3-16).

A number of products attempt to solve the distribution problems outlined above. One such product is the "Type on Call" product distributed by Adobe Systems, Inc. Type on Call is a CD-ROM that contains many different fonts. The CD-ROM is distributed to end users through conventional channels, and the end users must then contact and pay Adobe Systems, Inc. in order to receive a code necessary to activate one or more of the fonts. This approach has the disadvantage of requiring conventional distribution channels for the CD-ROM, and the further disadvantage of requiring the user to request an access code. (P. 2, ll. 23-28).

The email, network, and Internet service provider America Online, Inc. ("AOL") uses various methods to distribute its access software. One method is to distribute the software for free, and then charge the consumer for subsequent access to the AOL network. The software is provided free of charge, because the value is in the associated access service provided by AOL. A downside of the AOL model, however, is that it still requires use of traditional channels to distribute the software. In addition, accessing digital data over the Internet can still take a relatively long time, as compared to accessing data stored locally on a user computer. (P. 3, ll. 1-9).

Several embodiments of the present invention are directed to methods and systems for distributing software with a computer system to an end user. In one claimed embodiment, a method for distributing software includes recording data on a hard disk, optical disk, programmable read-only memory, or other fixed medium. (P. 6, ll. 1-7, and Figure 2). The method then includes transferring a computer system containing the fixed medium to a user. The user may be an end user, such as a consumer, or a reseller. (P. 6, ll. 24-25, and Figure 2). Once the computer system has been transferred to the user, access to the data is controlled by execution of computer code that implements authorization procedures. (P. 6, ll. 25-29, and Figure 2).

In the embodiment illustrated in Figure 3, the authorization procedures begin when a request to use the software application is first detected. (P. 7, ll. 2-4, and Figure 3). Next, the code automatically connects to the Internet or other network and presents a query to a party authorized to grant access to the software application. (P. 7, ll. 9-12, and Figure 3). If the party grants access to the software application, the user can access the data based on the authorization. In addition, the authorization is recorded in the software module, or in a location in the computer system that the software module can query. Thus, if the user attempts to access the data a second time, access will be granted based on the authorization recorded in the user's computer system. However, if the user is not authorized to access the data, access may be interrupted, or the function of the data may be disabled. Alternatively, the user may be presented with an opportunity to set up an account so that future access to the data will be granted. (P. 7, ll. 22-28).

As described above, embodiments of the present invention are directed to methods and systems that provide software applications and other digital data to end users in a relatively quick and easy manner. In this way, end users are encouraged to "impulse buy" software applications that they might otherwise forgo. For example, if a user develops a data processing need after purchasing a computer system, the user can easily activate a software application already loaded into his or her computer system to meet the need. Once activated, the system would automatically establish, or assist the user in establishing, the user's access permissions. Hence, embodiments of

the present invention provide significant advantages over the traditional approaches of traveling to a retail outlet to buy the software application, mail-ordering the software application, or downloading the software application. Further, because embodiments of the present invention provide for delivery of digital data on a fixed medium in an originally manufactured computer system, there are no additional shipping or inventory costs associated with delivery of the data. (P. 8, I. 16 to P. 9, I. 2).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether the admitted information about AOL in the Background section of the present application and U.S. Patent No. 5,438,508 to Wyman ("Wyman") disclose recording a data access authorization, received from a party authorized to grant access, in the same computer system in which the data is stored, as required to support a *prima facie* case of obviousness.

B. Whether the admitted information about AOL in the Background section of the present application and Wyman provide the teaching or suggestion to make the claimed combination and the reasonable expectation of success, as required to support a *prima facie* case of obviousness.

ARGUMENT

A *prima facie* case of obviousness requires, *inter alia*, that the prior art references teach or suggest *all* the claimed features. (MPEP § 706.02(j)). In the present case, the prior art references do not teach or suggest all the claimed features. For example, all the pending claims include, *inter alia*, the feature of recording a data access authorization, received from a party authorized to grant access, *in the same computer system* in which the data is stored. As explained in greater detail below, however, neither the admitted information about AOL nor Wyman teaches or suggests this feature. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1-29 for at least this reason.

A. Whether Applicant's Own Admission Regarding AOL and Wyman Disclose Recording a Data Access Authorization, Received from a Party Authorized to Grant Access, in the Same Computer System in Which the Data Is Stored

Claims 1-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over applicant's own admission regarding AOL in the Background section of the present application in view of Wyman. As discussed in detail below, independent claims 1, 10, and 21 all include the feature of recording an authorization to access data *in the same computer system* in which the data is stored. This data access authorization is *not* pre-stored in the computer system, but is received from *a party authorized to grant access* only after a first request to access the data has been received. Wyman does not teach or suggest this feature. In contrast, Wyman explicitly teaches recording temporary licenses *in a remote license server*. Further, the brief discussion about AOL in the Background section of the present application does nothing to correct the deficiencies of Wyman. Simply put, the mere statement that AOL "distributes free media containing its access software" (p. 3, l. 3) cannot reasonably be construed to teach or suggest that AOL then controls access to its software by recording an authorization in the user's computer system. This is especially true in light of the notoriously well-known fact that, as clearly explained in the Background section of the present application, *AOL does not control access to its software*, but instead "charges consumers for access to its connections and network." (P. 3, ll. 3-4) (emphasis added).

1. Claim 1 Is Directed to a Method of Distributing Software With a Computer System That Includes, *Inter Alia*, Recording a Data Access Authorization in the Computer System

Claim 1 is directed to a method of distributing software with a computer system. The method includes, *inter alia*, recording data on a fixed medium in the computer system and providing for transfer of the computer system to a user. The method further includes controlling access *to the data in the computer system* by contacting a party authorized to grant access when a first request for access is received. If the party authorizes access to the data, then the authorization is recorded *in the computer system* and access to data already in the computer system is granted based on the recorded authorization. When a second request for access to the data is received,

access is granted based on the authorization previously recorded *in the computer system*.

Independent claim 10 is directed to a software module in a computer system that controls access to a software application stored on a fixed medium in the computer system. The software module verifies authority to access the software application by, *inter alia*, contacting a party authorized to grant access to the software application. If the party provides authorization to grant access to the software application, the authorization is recorded *in the computer system* and access is granted based on the recorded authorization. When subsequent use of the software application is detected, access is granted based on the authorization recorded *in the computer system*.

Independent claim 21 is directed to a computer system operable to provide controlled access to a software application stored on a fixed medium in the computer system. The computer system includes, *inter alia*, a software module that responds to a first activation of the software application by contacting a party authorized to grant access to the software application. If the party provides authorization to grant access to the software application, the software module records the authorization *in the memory of the computer system*. When subsequent activation of the software application is detected, access is granted based on the authorization recorded *in the memory of the computer system*.

2. Applicant's Admission Regarding AOL Teaches That AOL Does Not Control Access to Its Free Internet Access Software, but Only Controls Access to the Related Service

In the Background section of the present application, applicant notes that "AOL sometimes directly distributes free media containing its access software, and subsequently charges consumers for access to its connections and network." (P. 3, ll. 2-4). Applicant goes on to explain, however, that one downside of the AOL model is that "it still requires traditional distribution of media or a relatively slow download." (P. 3, l. 7). In addition, applicant points out that with AOL, "*access to the software is not controlled*. The access control is with regard to the associated service." (P. 3, ll. 8-9) (emphasis added).

3. Wyman Is Directed to a License Management System in a Distributed Computer System That Stores Licenses (Product Use Authorizations) on a Remote License Server

As the first sentence of the Wyman Abstract clearly states, Wyman is directed to a "license management system" for use in a "distributed computer system." In Wyman, the licenses are stored on a *remote server computer*, and each product makes a call to the *remote server computer* "upon start-up" (i.e., *each time* the product is started) to determine whether use is permitted. Quoting from Wyman:

The license server maintains a store of the licenses, called product use authorizations, that it administers. *Upon receiving a call from a user*, the license server checks the product use authorization to determine if the particular use requested is permitted, and, if so, *returns a grant to the requesting user node*. *The license server maintains a database of product use authorizations* for the licensed products, and accesses this database . . . when a request is received from a user.

(Wyman at col. 6, ll. 57-66) (emphasis added).

4. Applicant's Own Admission Regarding AOL and Wyman Do Not Disclose Recording a Data Access Authorization, Received from a Remote Party, in the Same Computer System in Which the Data Is Stored

Independent claims 1, 10, and 21 all include the feature of recording a data access authorization *in the same computer system* in which the data is stored. In contrast, Wyman explicitly teaches recording data access authorizations (i.e., "licenses") *in a remote license server*. The Examiner has chosen to ignore this explicit teaching of Wyman, however, and instead construe the "handle" taught by Wyman as the claimed data access authorization. Specifically, the Examiner states:

With regard to the limitation of recording authorizations within the user computer system, Wyman . . . discloses storing the authorization handle on the client computer for future reference.

(Examiner's Answer at 5; Final Office Action at 6).

The handle taught by Wyman, however, *is not* a data access authorization. Indeed, as Wyman explains, the handle merely identifies the allocation grant created by a previous call to the license server. By using a handle, a subsequent request for

access is expedited by the server because the handle identifies the allocation granted during a previous call. (Wyman at col. 22; ll. 14-36). The fact that a handle is not an authorization is well understood by those of ordinary skill in the computer arts. For example, the Microsoft Press® Computer Dictionary states:

Programs often receive a handle in response to a request for a resource, and then they use the handle when they need to access the resource. When the program uses the handle, the value of the handle tells the system which resource, from the pool of resources maintained by the system, to use.

(See Microsoft Press® Computer Dictionary, 2nd Edition, 1994, at pg. 190)

Further, the Compaq® Fortran Language Reference Manual provides a similar definition of handle in its glossary as:

A value (often, but not always, a 32-bit integer) that identifies some operating system resource, for example, a window or a process. The handle value is returned from an operating system call when the resource is created; your program then passes that value as an argument to subsequent operating system routines to identify which resource is being accessed.

(See Compaq® Fortran Language Reference Manual at <http://h18009.www1.hp.com/fortran/docs/lrm/lrm-frames.html>).

Wyman also clarifies that the handle is not an authorization. For example, "[i]f the handle is valid, the authorization for this product is retrieved from the [server] database 23." (Wyman at col. 23, ll. 66-67) (emphasis added). Thus, the handle of Wyman cannot be construed as a data access authorization for the additional reason that Wyman explicitly states (1) the "handle" and the "authorization" are two different things, and (2) the "authorization" is stored in the server database, whereas the "handle" is stored on the user computer.

In fact, elsewhere in the Final Office Action, the Examiner appears to acknowledge that the handle taught by Wyman cannot be construed as the data access authorization of the pending claims. Specifically, the Examiner states: "... Wyman does not specifically disclose an authorization per se recorded on the user's hard drive."

(Final Office Action at 3, ¶ 6). Appellant agrees. But in an effort to fill the gap, the Examiner goes on to state:

... [o]ne of ordinary skill in the art [would] conclude that it is an obvious modification to store authorization data on a hard drive in light of AOL's technique of preloading software onto a computer before the computer [is] shipped to [a] user and Wyman's use of storing an authorization handle on the computer's hard drive.

(Examiner's Answer at 10; Final Office Action at 3, ¶ 6).

This unsupported assertion by the Examiner is insufficient to form the basis of a *prima facie* obviousness rejection for a number of reasons. First, the MPEP requires that the *applied references* teach or suggest all the features of the pending claims. (MPEP § 706.02(j)). Even assuming (and applicant expressly does not) that there was some motivation *in the prior art* to combine Wyman with the AOL reference, the resulting combination would still fail to produce the claimed invention because neither of these references teach or suggest the access authorization feature of the pending claims. For example, even when Wyman and the AOL reference are combined, the remote server in Wyman must still be accessed via a network to obtain the "authorization" to use the licensed software. The Examiner cannot dispense with the MPEP requirement that at least one reference teach the claimed feature by simply stating that "one of ordinary skill in the art [would] conclude that it is an obvious modification" to provide the missing feature.

Second, the proper legal standard for a *prima facie* obviousness rejection is not whether "one of ordinary skill in the art [would] conclude that it is an obvious modification" to produce the claimed invention. Rather, the proper legal standard includes, *inter alia*, whether the teaching or suggestion to make the claimed combination and the reasonable expectation of success are both found in the prior art, and not in applicant's disclosure. (MPEP 2143). Here, regardless of what the Examiner believes one of ordinary skill "[would] conclude" with hindsight of applicant's disclosure, the Examiner has still failed to identify *where the prior art* teaches or suggests making the claimed combination.

In the Examiner's Answer to the Appeal Brief, the Examiner points to a portion of the text in the Background section of Wyman as apparently providing support for his assertion that Wyman does teach recording a data access authorization in the same computer system in which the data is stored. Specifically, the Examiner states:

With regard to the limitation of *recording authorizations within the user computer system*, Wyman in at least column 23, lines 11-37 discloses storing the authorization handle on the client computer for future reference, and in at least column 4, lines 38-42 and lines 46-50 discloses that it was common practice in the art at the time of the invention to maintain individual licenses and store the license privilege proofs on each client system.

(Examiner's Answer at 5).

A close reading of the referenced text, however, will reveal that it does not teach the data access authorization of the pending claims for a number of reasons. First, this portion of Wyman is explicitly limited to a *client/server* licensing method. (See, for example, Wyman at col. 4, ll. 27, 38, and 39). Thus, the licenses referred to by this portion of Wyman are clearly not authorizations to access data stored on the user computer, but are instead licenses to access data stored on a remote server. Wyman clarifies this:

The solution to this transitive licensing problem would be to provide a mechanism that would allow the clients to obtain license unit allocations and then pass a "proof" of that allocation *to any servers they may wish to use*.

(Wyman at col. 4, ll. 46-50) (emphasis added).

Clearly, the "license unit allocations" and the "proof" taught here by Wyman are for use of a server, not for access to data stored on the user computer. In contrast, the data access authorization of the claimed invention is for controlling access to data recorded on a fixed medium *in the user computer system*. (See, for example, claim 1).

Second, the data of interest of the pending claims is stored in the same computer system in which the data access authorization is subsequently recorded (i.e., the user computer). But in contrast, the data of interest in the Wyman system is stored

in one computer system (i.e., a server computer), while the "license unit allocations" and the "proof" are recorded in another (i.e., the client computer). Specifically, Wyman teaches that the data accessed by the client computer is stored on "any server they may wish to use." Thus, the license/proof taught by Wyman and relied on by the Examiner is markedly different than the data access authorization of the pending claims for the additional reason that the license/proof is not stored on the same computer system as the accessed data.

The newly cited text of Wyman fails to teach the data access authorization of the pending claims for an additional reason. The claimed data access authorization is provided to the user computer system by "a party authorized to grant access." (See, for example, claim 1). Wyman does not teach this particular feature of the claimed invention anywhere in the cited text. To the contrary, all Wyman states in this regard is "The solution ... would be to provide a *mechanism* that would allow clients to obtain license unit allocations..." (Wyman at col. 4, ll. 46-47) (emphasis added). Nowhere does Wyman define what this "mechanism" is. More specifically, nowhere does Wyman state that the license unit allocations are provided by "a party authorized to grant access" *after* the party has been contacted by the user computer system. For at least the reasons set forth above, the newly cited text in Wyman still fails to provide the claim features identified in the Appeal Brief as missing from the applied references.

The prior art combination proposed by the Examiner on page 5 of his Answer cannot support a proper Section 103 rejection of the pending claims for yet another reason. According to the Examiner, Wyman discusses a system in the Background section of his patent in which product licenses are stored on a client computer. Based on this, the Examiner concludes that it would have therefore been obvious to modify Wyman's invention, which stores grant handles on the client computer, to instead store product licenses on the client computer. This conclusion, however, totally ignores the fact that Wyman's invention specifically calls for a system in which the product licenses *are not* stored on the client computer, but instead are stored on a server. (See, for example, Wyman in column 6 at lines 57-65 "The license server maintains a store of the licenses, called product use authorizations, that it administers"). Indeed, even the

Examiner admits that only the grant handle of Wyman is stored on the client computer. (Examiner's Answer at 5). Thus, the Examiner's suggestion that it would have been obvious to one of ordinary skill in the art to combine Wyman's invention of storing product licenses on a server computer with the alleged "common practice" of storing product licenses on a client computer directly contradicts the teaching of the Wyman reference, which expressly teaches that the product licenses should be stored on a server computer and not on a client computer. The MPEP is clear, "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." (MPEP 2141.02). Therefore, Wyman and Applicant's admission cannot support a proper Section 103 rejection of the pending claims for the additional reason that the prior art combination proposed by the Examiner directly contradicts the teaching of Wyman.

On page 9 of the Examiner's Answer under the Response to Argument heading, the Examiner states:

Appellants use of the Fortran Language Reference Manual is questionable at best not only because it provides no verifiable publication date, but also because there is no teaching within the specification or any of the prior art of reference that mandates that any of the systems in question be written only in Fortran.

(Examiner's Answer at 9).

The citation to The Fortran Language Reference Manual was not meant to suggest that any aspect of the claimed invention or the applied references was limited to Fortran. To the contrary, it was merely provided as an example of a common reference giving the same, well-known, definition for the word "handle" as proffered by the Appellant. Indeed, the present Reply Brief includes an additional cite to the Microsoft Press® Computer Dictionary as further support for the proffered definition.

For the reasons set forth above, the applied references fail to teach or suggest all the claimed features including, *inter alia*, recording a data access authorization, received from a party authorized to grant access, in the same computer system in

which the data is stored. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1, 10, and 21 for at least this reason.

B. Whether Applicant's Own Admission Regarding AOL and Wyman Provide the Teaching or Suggestion to Make the Claimed Combination and the Reasonable Expectation of Success

In addition to the requirement that the applied references teach or suggest all the claimed features, the MPEP also requires that the "teaching or suggestion to make the claimed combination, and the reasonable expectation of success, must both be found *in the prior art and not based on applicant's disclosure*." (MPEP § 706.02(j)) (emphasis added). In this regard, the MPEP further instructs the Examiner that "Although a prior art device may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." (MPEP § 2143.01).

In the present case, even assuming (and applicant expressly does not) that the applied references do teach all the claimed features, the Examiner still has not complied with the MPEP and (1) identified where *the prior art* suggests combining the AOL reference with Wyman or (2) identified where *the prior art* provides the motivation to make the proposed modification. Instead, all the Examiner states in this regard is:

[I]t is an obvious modification to store authorization data on a hard drive in light of AOL's technique . . . and Wyman's use of storing an authorization handle. . . ."

(Final Office Action at 3, ¶ 6).

Here, the fact that the Examiner states "it is an obvious modification," rather than the legal standard of "it *would have been* an obvious modification at the time the invention was made" suggests that the Examiner is using impermissible hindsight analysis to mold the applied references into the claimed invention. Regardless, the cursory statements about "AOL's technique" and "Wyman's use of storing an authorization handle" still fail to satisfy the basic requirements for a *prima facie* obviousness rejection for at least the reason that these statements say nothing of substance about *where the prior art references* actually suggest the claimed

combination. Absent a suggestion in the prior art, the Examiner has failed to establish a *prima facie* case of obviousness.

In an apparent attempt to provide further support for his assertion that the claimed invention is obvious, the Examiner goes on to state:

It would be of little burden or consequence to the public to modify these techniques to store a complete authorization on a user's computer.

(Office Action at 3, ¶ 6).

Applicant expressly disagrees with this statement. But more importantly, the proper legal standard for obviousness is not whether "[i]t would be of little burden . . . to the public to modify" the prior art to produce the claimed invention. To the contrary, as set forth above, the proper legal standard includes, *inter alia*, (1) whether the applied references teach or suggest *all* the claim features, and (2) whether the teaching or suggestion to make the claimed combination and the reasonable expectation of success are both found *in the prior art*. (MPEP § 706.02(j)). In the present case, as further set forth above, the applied references do not teach or suggest all the claimed features. Furthermore, even if they did, the Examiner has still failed to identify where the prior art, at the time the invention was made, provides the motivation to combine the references and/or modifying them to produce the claimed invention.

On page 4 of the Examiner's Answer to the Appeal Brief, the Examiner states:

Wyman ...discloses "...usage of licensed software may be monitored in a computer system to determine if a use is within the scope of a license".... It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the well-known method of pre-installing software onto a newly-purchased computer with Wyman's technique of enforcing usage rights and download privileges because this would entitle an authorized user to access digital data while preventing the unauthorized use f the same.

(Examiner's Answer at 4).

Appellant is at a loss to understand how this statement supports the conclusion that *the claimed invention* is obvious. Even if "It would have been obvious to ... combine the well-known method of pre-installing software onto a newly-purchased computer with Wyman's technique....," the resulting combination still does not result in the claimed invention. At most, the suggested combination would result in a pre-installed version of Wyman's license management system that, as Wyman explicitly teaches, is for use *in a distributed computer system*.

On page 5 of the Examiner's Answer, the Examiner further suggests that Wyman at column 4 discloses "it was common practice in the art at the time of the invention to maintain individual licenses and store the license privilege proofs on each client system." Based on this, the Examiner then asserts "it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize this technique in combination with the known standard of pre-installing software because, "such a licensing scheme makes it possible to charge customers only for the specific number of clients they purchase." (Examiner's Answer at 5).

Again, it is not clear to the Appellant how this passage provides support for the assertion that the claimed invention is obvious. Apparently, the Examiner is arguing that it would have been obvious to pre-install software and individual licenses on client computer systems. Even so, this is not the claimed invention. The claimed invention requires that the software be initially installed *without* a data access authorization. The data access authorization is only recorded on the client computer after (1) a first request for access to the data has been received, (2) a party authorized to grant access has been contacted, and (3) the party provides an access authorization to the client computer. (See, for example, claim 1).

Further, the Examiner's statement that "such a licensing scheme makes it possible to charge customers only for the specific number of clients they purchase" is misplaced and appears to be an effort on behalf of the Examiner to manufacture a motivation for the claimed combination. While Wyman does discuss such a licensing scheme in column 4, it is strictly in the context of a *client/server licensing method* which,

as set forth above, is distinctly different from the claimed invention which is concerned with licensing access to data stored on the user computer system, and not on a server.

For the various reasons set forth in detail above under Part A of this Brief, AOL and Wyman do not teach or suggest all the claimed features. Thus, the question as to whether there is motivation to combine these references to produce the claimed invention is moot. Nevertheless, the Examiner still has not provided a sufficient explanation of where the prior art provides the motivation to combine the references. On page 10 of the Examiner's Answer, for example, the Examiner states:

In addition, because both of the background and Wyman disclose techniques for maintaining only authorized use of digitized files by placing digital data on a client's hard drive, the motivation to combine is provided with the expected and desired result of maintaining positive control over proprietary data.

(Examiner's Answer at 10).

Here again, the Examiner has failed to identify where *the prior art references* provide the motivation for the combination. Instead, the Examiner has manufactured his own motivation by suggesting that because AOL and Wyman disclose efficient methods for "maintaining positive control over proprietary digital data," one would somehow be motivated to combine them to produce yet another system (e.g, the claimed invention) that also provides "positive control over proprietary data." Surely, this type of hindsight analysis is not what the MPEP contemplates by instructing Examiners to identify where the applied references provide the suggestion or motivation to combine references. (MPEP § 2143.01).

For the reasons set forth above, the Examiner has (1) failed to provide prior art references that disclose all the claim features and (2) failed to provide a teaching or motivation—in *the prior art*—to modify the references or combine reference teachings. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1, 10, and 21.

Claims 2-9 depend from base claim 1, claims 11-20 depend from base claim 10, and claims 22-29 depend from base claim 21. Accordingly, the Examiner has failed to

establish a *prima facie* case of obviousness with respect to dependent claims 2-9, 11-20, and 22-29 for at least the reasons discussed above with regard to the Section 103 rejection of the corresponding base claims, and for the additional features of these dependent claims.

C. Summary

The Examiner has improperly rejected claims 1-29 because the Examiner has failed to establish a *prima facie* case of obviousness. More specifically, the Examiner has (1) failed to provide prior art references that disclose all the features of the claims and (2) failed to provide a teaching or motivation—in the prior art—to modify the references or combine reference teachings. Accordingly, the Appellant respectfully requests that the Board reverse the rejection of claims 1-29.

CLAIMS INVOLVED IN THE APPEAL

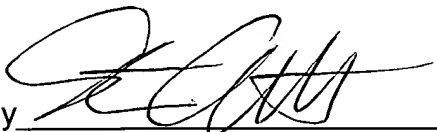
A copy of the claims involved in the present appeal is attached hereto as Appendix A.

Applicant believes no fee is due with this Reply Brief. However, if a fee is due, please charge our Deposit Account No. 50-0665, under Order No. 108298627US, from which the undersigned is authorized to draw.

Dated:

Jan 27, 2005

Respectfully submitted,

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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 09/518,787

1. (Previously Presented) A method of distributing software with a computer system to a user comprising the acts of:
 - recording data on a fixed medium in the computer system;
 - providing for transfer of the computer system to the user; and
 - controlling access to the data in the computer system by:
 - in response to receiving a first request for access to the data, contacting a party authorized to grant access to the data;
 - if the party provides authorization to grant access to the data, recording the authorization in the computer system and granting a first access to the data based on the recorded authorization; and
 - in response to receiving at least a second request for access to the data, granting a second access to the data based on the authorization recorded in the computer system.
2. (Original) The method of distributing software of claim 1 wherein the act of recording data on the fixed medium includes recording software application program instructions on the fixed medium.
3. (Original) The method of distributing software of claim 2 wherein recording software application program instructions on the fixed medium includes recording software application program instructions that enable a software application that does not depend on continued access to a network for fully functional operation.
4. (Original) The method of distributing software of claim 1 wherein the act of recording data on the fixed medium includes recording data on a hard disk drive.
5. (Original) The method of distributing software of claim 1 wherein the act of controlling access to the data includes the computer system automatically executing

computer readable instructions to contact a party authorized to grant access to the data.

6. (Original) The method of distributing software of claim 5 wherein executing computer readable instructions includes executing instructions to activate a network link.

7. (Original) The method of distributing software of claim 5 wherein executing computer readable instructions includes executing instructions to activate access to the Internet.

8. (Original) The method of distributing software of claim 1 wherein the act of controlling access to the data includes determining if a user has a sufficient account credit to continue access to the data.

9. (Original) The method of distributing software of claim 1 wherein the act of controlling access to the data includes determining if a user should be billed for accessing the data.

10. (Previously Presented) A software module used in a computer system operable to provide controlled access to a software application being stored on a fixed medium in the computer system and being distributed with the computer system, the software module operating by:

- detecting a first use of the software application on the computer system;
- in response to detecting the first use, verifying authority to access the software application by:
 - contacting a party authorized to grant access to the software application;
 - and
 - if the party provides authorization to grant access to the software application, recording the authorization in the computer system;

granting a first access to the software application based on the recorded authorization;
detecting at least a second use of the software application on the computer system; and
in response to detecting the second use, granting a second access to the software application based on the authorization recorded in the computer system.

11. (Original) The software module of claim 10 wherein the software application does not depend on continued access to a network for fully functional operation.

12. (Original) The software module of claim 10 wherein the software module and the software application are stored on the computer system during manufacture of the computer system.

13. (Original) The software module of claim 10 wherein verifying authority to access the software application verifies authority of a particular user to access the software application.

14. (Original) The software module of claim 10 wherein verifying authority to access the software application verifies authority of an accessing computer system to access the software application.

15. (Original) The software module of claim 10 wherein verifying authority to access the software application is accomplished through a network connection.

16. (Original) The software module of claim 10 wherein verifying authority to access the software application is accomplished through an Internet interface.

17. (Previously Presented) The software module of claim 10 further comprising:

if authority is verified, then allowing uninterrupted access to the software application; and

if authority is not verified, then interrupting access to the software application.

18. (Original) The software module of claim 17 wherein if authority to access the software application is not verified, then the user is presented with an opportunity to qualify for access to the software application.

19. (Original) The software module of claim 18 wherein the opportunity to qualify for access to the software application includes generating a request to set up an account.

20. (Original) The software module of claim 17 wherein if authority to access the software application is not verified, then the user's access to the software application is terminated.

21. (Previously Presented) A computer system operable to provide controlled access to a software application stored on a fixed medium in the computer system and distributed with the computer system comprising:

a processor;

a memory coupled to the processor; and

a software module executable on the processor and the memory, the software module being responsive to a first activation of the software application by:

contacting a party authorized to grant access to the software application;
and

if the party provides authorization to grant access to the software application, recording the authorization in the memory and granting

a first access to the software application based on the recorded authorization;

the software module being further responsive to at least a second activation of the software application by granting a second access to the software application based on the authorization recorded in the memory.

22. (Original) The computer system of claim 21 wherein the accessed software application does not depend on continued access to a network for fully functional operation.

23. (Original) The computer system of claim 21 wherein verifying authority to access the software application verifies authority of a particular user to access the software application.

24. (Original) The computer system of claim 21 wherein verifying authority to access the software application verifies authority of an accessing computer system to access the software application.

25. (Original) The computer system of claim 21 wherein verifying authority to access the software application is accomplished through a network connection.

26. (Original) The computer system of claim 21 wherein verifying authority to access the software application is accomplished through an Internet interface.

27. (Original) The computer system of claim 21 wherein if authority to access the software application is not verified, then the user is presented with an opportunity to qualify for access to the software application.

28. (Original) The computer system of claim 26 wherein the opportunity to qualify for access to the software application includes generating a request to set up an account.

29. (Original) The computer system of claim 21 wherein if authority to access the software application is not verified, then the user's access to the software application is terminated.